

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 070456-0056	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____ Signature _____ Typed or Printed Name _____		Application Number 10/506,505	Filed September 03, 2004
		First Named Inventor      Yoshihiro HORI, et al.	
		Art Unit 2439	Examiner Christian A. Laforgia
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).          Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 60,453 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center;">             _____            Signature         </div> <div style="text-align: center;">           _____            Typed or printed name  <b>Tomoki Tanida</b> </div> <div style="text-align: center;">           _____            Telephone number  <b>202.756.8000</b> </div> <div style="text-align: center;">           _____            Date  <b>8/31/09</b> </div>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

### **Remarks for Pre-Appeal Brief Request for Review**

Claims 1-16 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-9 of copending Application No. 10/522,176 (“ ‘176 application”). *See* the Examiner’s comments in paragraphs 10-12 of the Office Action issued May 29, 2009 (“Office Action”). Claims 1-16 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-15 of copending Application No. 10/340,832 (“ ‘832 application”). *See* the Examiner’s comments in paragraphs 13-15 of the Office Action.

There are clear errors in the Examiner’s position because the Examiner did not provide any evidential support as to why all the claimed limitations of the present application are taught by the claims of the ‘176 and ‘832 applications.

Appellants argued that the Examiner did not provide any factual basis as to why the limitations regarding, among other things, the first storage portion and the control portion are taught in the claims of the 176 and 832 applications (*see* Appellants’ February 18, 2009 response). In response, the Examiner asserted as follows (*see* paragraph 4 of the Office Action) (emphasis added):

The examiner agrees that the prior art does not teach the argued limitations, and asserts that was the reason for the obviousness-type double patenting rejection. The present invention and the invention of co-pending application 10/522,176 appear to be different embodiments of the same, or at least similar, base invention. In other words, both applications claim a species from a specific genus claim. Both independent claims are drawn to a data storage device performing input/output of classified data in accordance with certain procedures for the protection of said classified data. Furthermore, both inventions claim an interface portion for externally exchanging data; a storage portion for storing classified data, a log section for recording input/output information regarding the classified data, and a control portion for controlling the input/output of said classified data. For these reasons, the double patenting rejection is maintained.

Appellants submit that if “the prior art does not teach the argued limitations” (*see* the Examiner’s assertion), the claimed subject matter is not an obvious variation of the claims of the 176 and 832 applications. However, the Examiner asserted that the claimed subject matter is an

obvious variation of the claimed subject matter of the 176 and 832 applications because the subject matter of the present application and the cited applications are purportedly species of a common specific genus claim. Appellants respectfully disagree with the Examiner's position because (1) the Examiner's assertion that "both applications claim a species from a specific genus claim" is created by the Examiner without showing any evidentially support; and (2) the Examiner's assertion that "[b]oth independent claims are drawn to a data storage device performing input/output of classified data in accordance with certain procedures for the protection of said classified data does not teach, among other things, the following limitations of claim 1 of the present application:

said first storage portion further stores a flag, corresponding to said classified data, indicating whether said classified data can be used or not, and

said control portion [that controls the input/output of classified data] determines the state of storage of said classified data to be input/output in said first storage portion according to comparison of an identification code of classified data stored at a storage position in said first storage portion specified by said address [stored in the second storage portion] with an identification code stored in said second storage portion, and a state of said flag corresponding to said classified data to be input/output.

In addition, the Examiner's further assertion that "both inventions claim an interface portion...; a storage portion..., and control portion" does not show that the claimed subject matter is an obvious variation of the claims of the '176 and '832 applications because as admitted by the Examiner, the claims of the '176 and '832 applications do not teach all the limitation of the claims of the present application.

A double patenting rejection of the obviousness-type, if not based on an anticipation rationale, is analogous to the nonobviousness requirement of 35 U.S.C. §103 except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, the analysis employed in an

obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Legal precedent is well developed on the subject of obviousness in the application of a rejection under 35 U.S.C. § 103. It is incumbent upon the examiner to factually support a conclusion of obviousness. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The examiner must provide a reason why one having ordinary skill in the art would have been led to modify a particular prior art reference in a particular manner to arrive at a particular claimed invention; *Ecolochem Inc. v. Southern California Edison, Co.* 227 F.3d 361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The Examiner has not discharge his burden.

In paragraphs 11 and 14 of the Office Action, the Examiner asserted, “[t]he subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows (related subject matter shown as **bold**):...” (emphasis in original).

Appellants, however, submit that claim 1 of the present application is not an obvious variation of the claims of the ‘176 and ‘832 applications at least because the claims of those applications do not disclose or suggest, among other things, the following limitations recited in claim 1 of the present application:

said first storage portion further stores a flag, corresponding to said classified data, indicating whether said classified data can be used or not, and

said control portion [that controls the input/output of classified data] determines the state of storage of said classified data to be input/output in said first storage portion according to comparison of an identification code of classified data stored at a storage position in said first storage portion specified by said address [stored in the second storage portion] with an identification code stored in said second storage portion, and a state of said flag corresponding to said classified data to be input/output.

The Examiner simply addresses common limitations among the present application and the '176 and '832 applications. However, the Examiner did not explain why, for example, the claimed first storage portion storing a flag and the claimed control portion determining a state of the flag are obvious variation of the claims of the '176 and '832 applications. Again, the Examiner's assertion that the claims of the present application and the '176 and '832 applications are species of a common specific genus claim does not provide any reason why the claims of the '176 and '832 applications teach the claimed first storage portion storing a flag and the claimed control portion determining a state of the flag. The claims of the '176 and '832 applications are silent on such limitations.

Claim 1 of the 176 application simply includes the control portion that controls the input/output of the classified data, receives the identification information identifying the classified data to be input/output, searches a plurality of regions in the log storage portion in a predetermined order, determines the region storing the earliest item of the history information stored in the log storage portion as the earliest region, and newly stores the history information relating to the input/output processing of the classified data including the received identification information in the determined earliest region.

Claim 1 of the '832 application includes the control unit that controls that input/output of classified data, receives via the interface the identification information identifying classified data

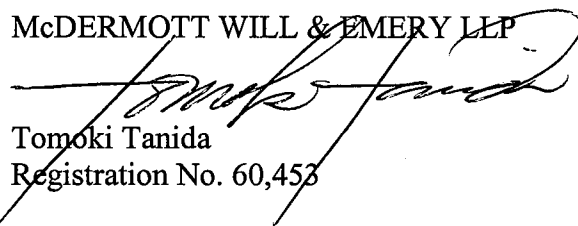
that has become a subject of input/output, selects a log storage unit that stores history information including the received identification information out from the plurality of log storage units storing the history information relating to input/output of the classified data when there is such a log storage unit, and stores history information according to a progress of a procedure for the classified data input/output into the selected log storage unit.

Based on the foregoing, there are clear errors in the Examiner's position because the Examiner did not provide any evidential support as to why the claimed subject matter of the present application is an obvious variation of the claimed subject matter of the '176 and '832 applications. Appellants respectfully solicit withdrawal of the double patenting rejection of claims 1-16 based on the claims of the '176 and '832 applications and favorable consideration thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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